

### REMARKS

An Information Disclosure Statement is submitted herewith (note that the references cited in the Information Disclosure Statement were all cited in the parent, U.S. Patent No. 6,693,858).

In the Office Action dated June 1, 2005, the Specification was objected to under 35 U.S.C. § 132(a); claims 11 and 16 were rejected under § 112, ¶ 1; claims 1-20 were rejected under the judicially created doctrine of obviousness-type double patenting over claims of U.S. Patent No. 6,693,858 (Reasoner); and claims 1-20 were rejected under § 103 over U.S. Patent No. 5,099,465 (Geiger).

#### REJECTION UNDER 35 U.S.C. § 132(a)

The Abstract and Summary of the Invention were objected to as containing new matter not supported by the original disclosure. The Abstract and Summary of the Invention have been amended to address the new matter objection.

#### REJECTION UNDER 35 U.S.C. § 112, ¶ 1

Claims 11 and 16 were rejected as lacking written description support in the Specification. Claims 11 and 16 have been amended to address the rejection. Therefore, withdrawal of the rejection is respectfully requested.

#### NON-STATUTORY DOUBLE PATENTING REJECTION

A Terminal Disclaimer is being submitted herewith to obviate the non-statutory obviousness-type double patenting rejection over claims of U.S. Patent 6,693,858.

#### REJECTION UNDER 35 U.S.C. § 103

All claims were rejected as being obvious over Geiger alone. It is respectfully submitted that the Office Action has failed to establish a prime facie case of obviousness for at least the reason that no motivation or suggestion existed to modify Geiger in the manner proposed to by the Office Action. *See* M.P.E.P. § 2143 (8<sup>th</sup> ed., Rev. 2), at 2100-129.

Claim 1 recites a method that comprises emitting a signal from a signal emitter on a cartridge engaging assembly into a chamber formed *within* the cartridge engaging assembly; detecting at least a portion of said emitted signal when said emitted signal is reflected from the data cartridge (that is *in* the cartridge engaging assembly); and generating output to indicate

whether the data cartridge is present *in* the cartridge engaging assembly based on the detected signal.

In contrast, Geiger describes a playback section 1 (*see* Fig. 1 of Geiger) that is able to remove compact disks (CDs) from a separate magazine 4. The magazine 4 contains CDs. A light source 8 and a photoelectric element 10 are both mounted on the playback section 1. Geiger clearly does not disclose the ability to detect if a data cartridge is present in the playback section 1, a point that was conceded by the Office Action. *See* 6/1/2005 Office Action at 6-7. However, the Office Action stated that it would have been obvious to a person of ordinary skill in the art to modify Geiger to detect a data cartridge located within a cartridge engaging assembly as recited in claim 1.

Applicant respectfully disagrees with this conclusory statement in the Office Action. The proposed modification of Geiger made in the Office Action is not based on any objective evidence cited by the Office Action. In sum, the Office Action *concluded* that Geiger *could be* modified in the manner proposed, with no objective evidence (either a reference that would have suggested the requisite modification of Geiger or other evidence establishing knowledge available to a person of ordinary skill in the art that would have motivated the modification of Geiger as proposed in the Office Action). No such objective evidence was provided in the Office Action.

Geiger is unambiguous in teaching that the light source 8 and photoelectric element 10 provided on the playback section 1 is used for the purpose of detecting whether a CD is located in some external structure: the magazine 4. Geiger, 2:43-3:5. There is no suggestion whatsoever within Geiger that the light source 8 and photoelectric 10 can be used to detect presence of a CD in the playback section 1. In fact, there is no suggestion in Geiger of any desirability to perform such a detection of a CD in the playback section 1. No other objective evidence supports the modification of Geiger proposed by the Office Action. Therefore, as no motivation or suggestion existed to modify the teachings of Geiger, a *prime facie* case of obviousness has not been established with respect to claim 1.

Independent claims 6 and 7 are allowable for similar reasons.

Independent claim 10 recites a method that comprises detecting a signal reflected from a data cartridge in a *picker assembly*, and moving the picker assembly after a loading operation if

the detected signal indicates the data cartridge is engaged *in* the picker assembly. As discussed above, the light source and photoelectric element 10 on the playback section 1 of Geiger are used to detect for presence of a CD in an external magazine 4, not in the playback section 1. No suggestion is provided in Geiger of any desirability to use the light source 8 and photoelectric element 10 to detect the presence of a data cartridge in the picker assembly.

Independent claim 15 is allowable for reasons similar to those of claim 10.

Dependent claims, including newly added dependent claims 21-25 are allowable for at least the same reasons as corresponding independent claims.

Moreover, with respect to claim 5 (which depends from claim 1), there is no suggestion whatsoever in Geiger of deciphering a color of the data cartridge based on the detected signal. The Office Action stated that this feature would have been obvious in view of Geiger since "Applicant did not invents [sic] this color-deciphering component, just applies this well known color-deciphering component in the light detector for determining the color of data cartridge." (6/1/2005 OA at 8-9).

This obviousness rejection is clearly defective, as the Office Action has failed to cite to any reference or any objective evidence that would have suggested a modification of Geiger to decipher a color of a data cartridge. Absent the requisite evidence to suggest the modification of Geiger to incorporate the claimed feature, a *prima facie* case of obviousness is defective for this additional reason with respect to claim 5.

Claims 12 and 14 (which depend from claim 10) are allowable for similar reasons. Claims 18 and 20 (which depend from claim 15) are also allowable for similar reasons. Claim 24 (which depends from claim 6) is also allowable for similar reasons.

Claims 13 and 19 (which depend from claims 10 and 15, respectively) were rejected for "the same reasons set forth in claim 5 above." 6/1/2005 Office Action at 10. Claim 13 recites identifying a type of the data cartridge, and claim 19 recites a processor identifying a type of the data cartridge. Claim 5 does not recite identifying a *type* of a data cartridge -- therefore, the rejection of these claims based on the rejection of claim 5 is defective. Moreover, there simply did not exist any suggestion in Geiger, or in any other reference, of modifying Geiger to perform identifying a type of a data cartridge, as recited in the claims.

With respect to claim 25, which depends from claim 6, Geiger fails to teach or suggest a signal detector to detect a characteristic of a surface of the data cartridge.

In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10012665-4).

Respectfully submitted,

Date: \_\_\_\_\_

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